

Inventors: Border and Ruoslahti  
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Filed: December 2, 1994  
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whereby the binding of the anti-TGF- $\beta$  antibody to the TGF- $\beta$  suppresses the deleterious accumulation of the TGF- $\beta$ -induced extracellular matrix in the tissue, and wherein the pathology or condition is glomerulonephritis.

#### REMARKS

Claims 21 to 23 and 25 are presently under examination. Claim 21 has been amended and claims 22, 23, and 25 are cancelled herein.

As amended, claim 21 is directed to a method of decreasing the deleterious accumulation of extracellular matrix (ECM) associated with a pathology or a condition characterized by the TGF- $\beta$ -induced production and deleterious accumulation of extracellular matrix in a tissue, wherein the pathology or condition is glomerulonephritis. The amendment to claim 21 merely incorporates the species recitation of dependent claim 22, which is cancelled herein and accordingly does not introduce any new matter. Accordingly, entry of the amendment in accordance with 37 C.F.R. § 1.196(b)(1) is respectfully requested.

In its Decision on Appeal from final rejection, the Board indicates at pages 3 and 4 of its Decision mailed December 19, 2002, that Appellants' claim 21, as presented on Appeal, and claim 1 of the Dasch '998 patent are directed to the same patentable invention. Under these circumstances, the Board states at page 4 of its Decision, the issue of priority cannot be resolved through the use of a Rule 131 Declaration, but rather,

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if appropriate, only through an interference proceeding. The Board goes on to characterize their Decision as containing a new ground for rejection pursuant to Rule 196(b), which states in relevant part:

(b) ... When the Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) **Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner.** The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal pursuant to §§ 1.191 through 1.195 to the Board of Patent Appeals and Interferences.

As amended herein, claim 21 is not directed to the same patentable invention as claim 1 of the Dasch '998 patent. In particular, the Dasch patent does not disclose the treatment of glomerulonephritis.

Applicants respectfully submit that the Rule 131 Declaration of March 15, 2001, and accompanying Exhibits A

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through E, which have been addressed extensively on the record, including in the Appeal Brief filed October 15, 2001, establish Applicants' conception of the claimed methods of treating glomerulonephritis prior to December 22, 1988, as well as Appellants' diligence in the pursuit of reducing to practice the claimed methods from prior to December 22, 1988, until the filing of the priority application.

Briefly, with regard to glomerulonephritis, Exhibit C to Applicants' aforementioned Rule 131 Declaration, is a conference abstract entitled "Transforming Growth Factor- $\beta$  (TGF- $\beta$ ) Uniquely Regulates Production of Glomerular Extracellular Matrix" that was presented at the Meeting of the American Society of Nephrology in San Antonio, Texas, which took place from December 11 to 14, 1988. As Applicants have previously set forth on the record, the abstract explicitly indicates that "TGF- $\beta$  is unique among growth factors in its metabolic effect on glomerular ECM" and that the release of TGF- $\beta$  in glomerulonephritis could stimulate the expansion of ECM and progression to glomerulosclerosis. Accordingly, at the time the abstract was submitted and prior to the priority date of the Dasch '998 patent, Applicants already had conceived of using anti-TGF- $\beta$  antibodies in order to decrease deleterious TGF- $\beta$ -induced production and accumulation of extracellular matrix (ECM) associated with glomerulonephritis. Thus, Appellants Rule 131 Declaration and accompanying exhibits show that Appellants, prior to December 22, 1988, had conceived of the applicability of their claimed invention as defined by amended claim 21.

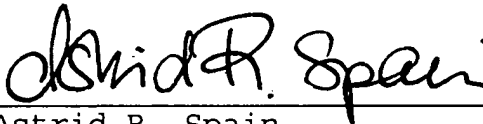
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CONCLUSION

In light of the Amendments and Remarks herein,  
Applicants submit that the claims are now in condition for  
allowance and respectfully request a notice to this effect.  
Should the Examiner have any questions, he is invited to call  
Cathryn Campbell or the undersigned attorney.

Respectfully submitted,

February 19, 2003  
Date



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Attachment: Appendix A

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#### Appendix A

21. A method of decreasing the deleterious accumulation of extracellular matrix associated with a pathology or a condition wherein TGF- $\beta$ -induced production and deleterious accumulation of extracellular matrix in a tissue exists comprising:

contacting the tissue with an anti-TGF- $\beta$  antibody that binds to TGF- $\beta$ ;

whereby the binding of the anti-TGF- $\beta$  antibody to the TGF- $\beta$  suppresses the deleterious accumulation of the TGF- $\beta$ -induced extracellular matrix in the tissue, and wherein the pathology or condition is glomerulonephritis.